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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,813	07/01/2001	David Bartholomew	4238P	2560

7590 07/13/2006

Lloyd W. Sadler
MCCARTHY & SADLER, LC
Suite 100
39 Exchange Place
Salt Lake City, UT 84111

EXAMINER

LU, SHIRLEY

ART UNIT	PAPER NUMBER
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2612

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/897,813

Applicant(s)

BARTHOLOMEW ET AL.

Examiner

Shirley Lu

Art Unit

2612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant traverses the Official Notice given in the previous Action, that "a set top box having a personal computer function like PCTV is notoriously well known in the art". The examiner provides a reference that teaches the above (US 5907322 to Kelly et al).

Applicant's arguments with respect to claims 3 and 4 have been considered but are moot in view of the new ground(s) of rejection, as necessitated by applicant's amendment.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 2, and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bullock (WO 99/52220).

As to claim 1, the claimed "base unit connected to an AC power line..." and claimed "extension unit connected to an AC power line..." is met by the base unit 101 connected to A/C power line link 106 which "transmits and receives data over the link 106 to the extension unit 107" (page 7, lines 2-3).

Bullock does not explicitly disclose a set top box.

However, the examiner gives Official Notice that a set top box having a personal computer function like PCTV is notoriously well known in the art. Accordingly, it would have been clearly obvious to one of ordinary skill in the art to modify the Bullock reference such that the computer is replaced with PCTV having computer and set top box functions as to facilitate Internet access through common TV displays, since a PCTV is nevertheless regarded as a set top box despite added functions. Furthermore, although Bullock does not explicitly disclose a central office, there inherently exists a central office with the existence of telephone type service connections 105 since Bullock discloses a cable connection service (page 6, line 15).

As to claim 2 and claim 3, Bullock does not expressly teach wherein the base or extension unit does not provide ringer and caller identification functions.

Official notice is taken that at the time the invention was made, it was conventional for telephone systems to have ringer and caller identification functions.

Furthermore, it has been held that the omission of an element and its function is obvious if the function of the element is not desired. *Ex parte Wu*, 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989) and *In re Larson*, 340 F.2d 965, 144 USPQ 347 (CCPA 1965) and *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bullock such that in the base and extension units, ringer and caller identification functions are omitted. The motivation would have been to save costs in production, since these features may not be desired or necessary in certain applications.

As to claim 4, although Bullock (WO 99) does not specifically disclose an 'extension unit embedded in a set top box,' Bullock (WO 01) discloses an 'extension unit 105 that is electrically connected to and installed within an otherwise standard set top box 106' (page 9, lines 2-3) (claimed embedded extension unit in said set top box). Therefore, it would have been clearly obvious to one of ordinary skill in the art to modify the Bullock (WO 99) reference by embedding the extension unit 107 in the set top box 112, as to incorporate both the extension unit and set top box in one housing to make the product more appealing to the consumer in that more functions are available within the set top box itself. Furthermore, although the Bullock (WO 01) reference discloses an extension unit 105 controller 304 (page 10, line 3), the examiner gives Official Notice that it is notoriously well known in the art to integrate controllers of the set top box and embedded extension unit into one control system, more specifically allowing the set top to control the extension unit, as to allow control centralization and simplicity in circuitry. Therefore, it would have been clearly obvious to one of ordinary skill in the art to further modify the Bullock (WO 99) reference to allow the set top box to control the embedded extension unit.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shirley Lu whose telephone number is (571) 272-8546. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Hofsass can be reached on (571) 272-2981. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SL


JEFFERY HOFSAASS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600